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J. Michael Neary
53939 Pine Grove Road
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In re Application of	:	DECISION ON PETITION
Gerald JULIEN	:	UNDER 37 CFR 1.181
Application No. 10/505,356	:	
Filed: August 19, 2004	:	
For: NITINOL ICE BLADES	:	

This is in response to applicants' petition under 37 CFR 1.181 filed May 6, 2009 requesting the examiner to respond to the applicant's Request for Clarification filed on February 9, 2009 regarding a rule 1.132 declaration (the Declaration) by Ms. Susan Buchanan submitted on June 30, 2006 and a test result report (the Report) filed August 4, 2008.

The petition is **GRANTED**.

The applicant is requesting a review of the Declaration and the Report. Applicant alleges that neither has been fully addressed during the prosecution of the application.

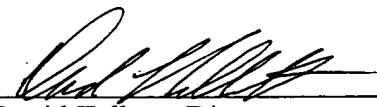
A review of the record reveals that the Declaration under 1.132 was originally filed June 30, 2006 along with an amendment in a response to the first non-final Office action dated March 31, 2006. A restriction requirement was made on September 1, 2006 restricting between group I of claims 1-4 and 6-12, and group II of claim 5. Applicant made a response on October 2, 2006 electing group I of claims 1-4 and 6-12, canceling claim 5 and adding claims 13-15. The examiner mailed a second non-final Office action on October 17, 2006, but did not address the Declaration. The applicant filed a Request for Clarification October 20, 2006 requesting that the Declaration be entered and considered, and then filed an amendment January 17, 2007 with a copy of the Declaration, and requested that the Declaration be considered again. A supplemental response was filed February 28, 2007. The examiner mailed a final Office action May 21, 2007, but did not fully address the Declaration. Applicant filed an appeal brief October 16, 2007, and in response, the examiner mailed a third non-final Office action on February 11, 2008. Applicant filed a request for reconsideration May 12, 2008, and on August 4, 2008, filed the Report providing additional evidence related to the Declaration. The examiner mailed a second final Office action on February 6, 2009, but did not fully address the Declaration nor the Report. A Request for Clarification was filed February 9, 2009 requesting that the Declaration and Report be addressed. Applicant then filed a petition under 37 CFR 1.181 on May 6, 2009 and ultimately an appeal brief July 6, 2009. An examiner's answer was mailed September 2, 2009 and a reply brief was filed November 2, 2009.

MPEP § 716.01 (B) specifies that "Evidence traversing rejections, when timely presented, must be considered by the examiner whenever present. All entered affidavits, declarations, and other evidence traversing rejections are acknowledged and commented upon by the examiner in the next succeeding action. The extent of the commentary depends on the action taken by the examiner. Where an examiner holds that the evidence is sufficient to overcome the *prima facie* case, the comments should be consistent with the guidelines for statements of reasons for allowance. See MPEP 1302.14. Where the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements such as "the declaration lacks technical validity" or "the evidence is not commensurate with the scope of the claims" without an explanation supporting such findings are insufficient."

It is clear from the record that the examiner has not specifically explained why the Declaration and Report is insufficient to overcome the *prima facie* case. A new Office action will be mailed fully addressing the Declaration and Report.

The application will be forwarded to the examiner of record to treat the Request for Clarification filed February 9, 2009, the Report filed August 4, 2008, and the Declaration under Rule 1.132 filed January 17, 2007 (originally filed June 30, 2006).

Any questions regarding this decision should be directed to Supervisory Patent Examiner Paul Dickson at (571) 272-7742.



David Talbott, Director
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pnd/lm: 5/11/10

LM